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Fadok, Mark A.

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LH 005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Catherine LIN-HENDEL

Ser. No.: **09/619,255**

Filed: **July 19, 2000**

For: **SYSTEM AND METHOD FOR
INTERACTIVE, COMPUTER ASSISTED
PERSONALIZATION OF ON-LINE
MERCHANDISE PURCHASES**

Group Art Unit: **3625**

Examiner: **Mark A. FADOK**

Attorney File No.: **LH 005**

Examiner's Answer Mailed On:

October 30, 2006

REPLY BRIEF TO THE
BOARD OF PATENT APPEALS AND INTERFERENCES

This Reply Brief is responsive to the Examiner's Answer mailed on October 30, 2006, in the above-referenced patent application (the "Examiner's Answer"). The Examiner's Answer contains a new ground of rejection. Consequently, Applicant-Appellant requests maintenance of the Appeal. See 37 C.F.R. § 41.39(b). This Reply Brief is being filed within two months of the mailing date of the Examiner's Answer. Therefore, the Reply Brief is timely. In accordance with MPEP § 1208(I), the Reply Brief includes these status pages, status of claims page, grounds of rejection to be reviewed on appeal pages, and argument pages.

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No fees are needed to file this Reply Brief. If the undersigned attorney is mistaken in this regard, authorization is hereby granted to charge all fees necessary to file this Reply Brief to Deposit Account No. 50-3196.

Applicant-Appellant relies on the Appeal Brief dated August 14, 2006, for exposition of the grounds for reversal of the rejections, and takes this opportunity to respond to a number of arguments made in the Examiner's Answer, including the new ground of rejection. Applicant-Appellant intends this Reply Brief to supplement the Appeal Brief, rather than to replace it.

I
STATUS OF CLAIMS

The status of claims in the instant application is as follows:

Claims 1-10 and 12-22 are pending.

Claims 1-10 and 12-21 have been rejected.

Claim 22 has been withdrawn from consideration.

Applicant appeals from the rejection of claims 1-10 and 12-21.

II

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 3-5, 9, 10, 16, and 20 apparently stand rejected under 35 U.S.C. 102(e) as being anticipated by Danish *et al.*, U.S. Patent Number 6,327,588 (“Danish” hereinafter) in view of Official Notice. We say “apparently” because the Final Office Action and the immediately preceding Office Action rejected claims 1, 3-5, 9, 10, 16, and 20 “under 35 U.S.C. 103(a) as being unpatentable over Danish et al (6,412,012) in view of Official Notice.” Similarly, the Examiner’s Answer rejected these claims under 35 U.S.C. § 102(e) “as being anticipated by Danish et al (6,412,012).” The applicants in United States Patent Number 6,412,012 were Bieganski *et al.*, not Danish *et al.* The Bieganski patent was used as a ground of rejections in one of the previous Office Actions, which rejections have been overcome. On the other hand, Danish is also used as a ground of rejections of certain dependent claims made in the Final Office Action, in the immediately preceding Office Action, and in the Examiner’s Answer. It appears therefore that citing “Danish et al (6,412,012)” was a clerical error in the Final Office Action and in the Examiner’s Answer, and the intended reference is Danish *et al.*, U.S. Patent Number 6,327,588. We proceeded on this assumption in the Appeal Brief, and, in the absence of a contrary indication in the Examiner’s Answer, continue to proceed on this assumption in this Reply Brief.

2. Claims 2, 6-8, 12-15, and 17-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Danish in view of Official Notice and in further view of Weaver, U.S. Patent Number 6,404,426 (“Weaver” hereinafter).

3. Claim 21 apparently stands rejected under 35 U.S.C. 103(a) as being unpatentable over Danish in view of Official Notice, Weaver, and further in view of Hashimoto, U.S. Patent Number 5,729,699 ("Hashimoto"). Here we note once again that the Examiner's Answer referred to "Danish et al (6,412,012)," but apparently the intended reference is Danish, *i.e.*, U.S. Patent Number 6,327,588, and proceed on this assumption.

III **ARGUMENT**

A. Rejection of Independent Claim 1

The Examiner's Answer asserted that Danish discloses all features of claims 1, 3-5, 9, 10, 16, and 20, and therefore anticipates these claims.

A "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). (Both *Verdegaal* and *Richardson* cases are quoted with approval in MPEP § 2131.) Here, Danish does not disclose the identical invention.

For convenience of discussion, claim 1 is set forth below:

1. An electronic system for purchasing merchandise online using a computer having a display device, comprising:

means for selecting and purchasing merchandise, by a user, online; and

an interactive wizard guide, selectively and optionally deployed by the user, for making online merchandise recommendations and computer-assisted selections tailored to said user, said interactive wizard guide comprising:

means for prompting the user to specify preferences regarding at least one type of merchandise of interest to said user, said prompting means includes means for prompting the user to answer a plurality of questions,

means for receiving the preferences and answers to the plurality of questions to create a user profile,

means for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise,

means, in response to said retrieving means, for displaying on said display device, said recommendations and said selections of said merchandise and said accessories, and

means for overriding said interactive wizard guide.

The system recited in claim 1 thus includes “means for searching in and retrieving data . . . using predetermined intelligence rules together with said user profile to determine said recommendations and said selections” In rejecting this claim, the Examiner’s Answer apparently equated this limitation with simple parametric search operations of Danish. See the Examiner’s Answer at page 3, last line, through page 4, first paragraph.

In computer software context, the expressions *intelligence*, and more to the point here, *intelligence rules*, generally refer to the ability of a program to respond to changing stimuli and to simulate human thought. See, e.g., COMPUTER DICTIONARY 278, (Microsoft, 5th ed., 2002). In light of the specification of this application, a person skilled in the art would have understood “using predetermined intelligence rules together with said user profile” as application of at least some logic and reasoning to the profile information to determine the resulting recommendations. Consider, for example, the teaching of “artificial intelligence coordination rules of the matching colors, fabric, styles, cuts and descriptions matching apparel items and accessories.” Specification, page 17, lines 14-20. As another example, consider the teaching of “[a] search engine, with comparison functions, artificial intelligence rules and user input rules for acceptance, rejection, recommendation, and change specification” Specification, page 18, lines 5-6. Indeed, the specification illustrates the use of

artificial intelligence rules time and again. Such use of “intelligence rules” in the specification is consistent with the generally accepted use in the art of the expressions “intelligence” and “intelligence rules.” But even redefinition of a claim term in the specification – which is not the case here – need not be explicit, but may be achieved “by implication.” *Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1268, 59 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2001) (“[A] claim term may be clearly redefined without an explicit statement of redefinition.”); *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1344, 58 U.S.P.Q.2d 1059, 1065 (Fed. Cir. 2001). Given the teaching of the specification, a person skilled in the art would have understood “using predetermined intelligence rules together with said user profile to determine said recommendations and said selections” as requiring application of logic and reasoning to the selection process, not merely as a search based on a user-supplied parameter.

The Final Office Action (page 5) and Examiner’s Answer (page 4) asserted that “Danish teaches using artificial intelligence rules to match the merchandise with the accessories and producing a list of results (FIG 21-24).” Danish’s Figures 21-24 illustrate program flows for feature screen creation operations, Search operation initiated from the feature screen, and feature screen revision operation. Danish, col. 4, line 62, through col. 5, line 5. Danish describes the functions of the feature screen 9 in these words:

The feature screen 9, therefore, provides a guided search in that it presents terminology for the features 5 and the alternatives 6 to the user prior to a search.

. . .

While in the feature screen 9, the user may select and deselect turning radiobuttons 23 and listbox entries 16 “on” and “off” as desired. In response to a user initiated signal to perform a search, the system retrieves information concerning which user selectors 16, 23 are turned “on” and to which alternatives 6 the user selectors 16, 23

that are turned “on” relate. The alternatives 6 turned “on” are the selected alternatives 37 and constitute the selection criteria 14 used in the search to generate a subfamily 2.

Danish, col. 7, lines 36-55 (emphasis added). See also Figures 7-9, which show different views of the feature screen. This appears to be a disclosure of search/retrieval based only on user-selected criteria, rather than intelligence rules. Consequently, Figures 21-24 (which illustrate feature screen operations) also show such search/retrieval.

Danish’s Abstract is to the same effect. The feature screen has a series of groupings. Danish, the Abstract. “Each grouping represents a feature having a set of alternatives from which to select. Selected alternatives are used as a selection criteria in a search operation.” *Id.* (emphasis added). Thus, the feature screen is an interface allowing the user to select the desired feature choices for the connectors. The system then performs a search operation, and “[r]esults of the search operation is a revised feature screen indicating alternatives that remain available to the user for further selection and searching.” *Id.*

In performing the search operation from the feature screen, Danish’s system does not use intelligence rules, such as color coordination rules. Instead, Danish’s system searches based on explicit selections of the user, and it matches the selections to the available connectors.

The Examiner’s Answer (at page 9) cited Danish’s text in column 3, lines 50-65, for the proposition that “intelligence rules must be present to sift through the plethora of permutations in determining what alternatives are available.” This appears to be an inherency argument. But intelligence rules need not be inherently present if, as Danish in fact discloses, the user’s selections are iteratively narrowed through multiple Alphabetical, Picture, View Catalog, or Get Part Number

Information searches. Danish, col. 5, line 54-61. These methods are further described in Danish, column 5, line 67 *et seq.* Allowing a user to make selections based on product qualifiers and attributes (alphabetical, picture, catalog, P/N description) is not the same as using the user's profile to determine recommendations. Danish's search is an interactive, iterative process during which the user makes selections. *E.g.*, Danish, col. 8, line 66 through col. 9, line 16; *see also id.* at col. 16, lines 17-23 and 38-39. In contrast, the means for searching of claim 1 uses "said user profile to determine said recommendations" – inherently requiring the profile to have been created previously, *i.e.*, before the search. In Danish, however, the profile need not be created at all, because the selection process is interactive and iterative.

As we have previously argued, Danish also fails to disclose using predetermined intelligence rules together with the profile to determine the recommendations. In response, the Examiner's Answer continues to assert (at page 7) that the phrase "user profile" means "any information that is saved (even temporarily) from a users session."

A user profile created from the preferences and answers provided by the user is not the same as *any information that is saved from a user's session*. Such broad definition of *user profile* is contrary to the language of claim 1, and has no basis in either the specification of the present application, or the art.

A dictionary defines the word *profile* in the present context (*i.e.*, context unrelated to public exposure or outlining) to mean "a set of data often in graphic form portraying the significant features of something." Merriam-Webster Online Dictionary, available online at <http://www.m->

w.com/dictionary/profile. (Note that the present invention does not require the use of profile in graphic form.)

Moreover, claim 1 explicitly recites “means for receiving the preferences and answers to the plurality of questions to create a user profile.” The profile is therefore created using the answers provided by the user and the preferences that are specified by the user (see the “means for prompting” clause of claim 1). The *user profile* recited in the claims is not just “any” information stored from a user’s session.

Danish does not teach means for creating a profile of the user from the preferences specified by the user and answers to the questions provided by the user, or using the user profile so created to determine recommendations.

At least for these reasons, Applicant respectfully submits that Danish does not anticipate claim 1.

B. Rejection of Dependent Claim 2

Claims 2, 6-8, 12-15, and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Danish in view of Official Notice and further in view of Weaver. According to the Final Office Action (page 6), “[i]t would have been obvious to a person having ordinary skill in the art to include in Danish the virtual modeling capabilities as taught by Weaver, because this type of preview allows the user to become more comfortable with the purchased articles when the transaction is done online (col 1, lines 15-20).”

We have argued in the Appeal Brief that the motivation to supplement Danish with virtual clothes modeling of Weaver stated in the Final Office Action does not apply in the context of electrical connectors, which are not modeled in the same sense as clothing. Moreover, the motivation to combine offered by the Final Office Action apparently would not apply to commercial products, as opposed to clothing intended for personal use. In response to these arguments the Examiner's Answer (at page 8) now proposes a different motivation: "having the capabilities of Weaver's three dimensional display would clearly help those that would prefer pictorially identifying a part as is evident i[n] Danishes Picture Search (FIG 3)." This statement does not explain the motivation to add "animation and morphing program for providing image and motion creation and morphing to models," which is recited in claim 2. It appears that neither in Figure 3 nor elsewhere does Danish disclose or suggest a need for animation and morphing. Indeed, if Danish taught animation and morphing capabilities, there would be no need to rely on the Weaver reference for the rejection of claim 2.

The Final Office Action also asserted (page 5) that "Weaver teaches a layout and schematics program for preparing and displaying a floor plan depicting merchandise selected by the user (FIG 7, analogous to mannequin trying on clothes)." We argued that *analogous* does not mean *obvious*, and that even functionally or mechanically equivalent components are not necessarily obvious in view of one another. MPEP § 2144.06 (citing *In re Scott*, 323 F.2d 1016, 139 U.S.P.Q. 297 (CCPA 1963)); *see also In re Mayne*, 104 F.3d 1339, 1342, 41 U.S.P.Q.2d 1451, 1454 (Fed. Cir. 1997). A mere invocation of "analogous" thus does not serve as a substitute for a suggestion to modify or combine the references. The Examiner's Answer (page 9) now replaces "analogous" with "interchangeable,"

and concludes that “appellant obviously agrees that these are interchangeable within a system, since appellant uses both a clothing/avatar and appliance/floor-plan embodiment.” This conclusion is baseless. Even if the capabilities are interchangeable, their interchangeability is disclosed within Applicant’s system. The Examiner’s Answer is attempting to use Applicant’s own disclosure to show a suggestion to combine. This it may not do. The suggestion must be founded in the prior art, not in the Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

At least for these reasons, Applicant respectfully submits that the Final Office Action and the Examiner’s Answer have not made a *prima facie* case of obviousness of claim 2, and that this claim is separately patentable over the references of record.

C. Rejection of Dependent Claim 4

In the Appeal Brief, we argued that in contrast to the plurality of vendors recited in claim 4, Danish’s system searches through products of a single vendor, AMP Incorporated. See, for example, Danish, Figures 1, 31-33, and 35. See also Figures 5, 7-10, and 26-30, which show products and the trade name FASTON®, a trademark of AMP Incorporated. Danish, col. 5, lines 42-45. The Examiner’s Answer (page 9) responds to this argument by pointing to Applicant’s own disclosure of “pull down menu where a distinguishing parametric (vendors) can be a source for limiting the selection of products.” Again, the Examiner may not use the Applicant’s disclosure of the invention to show obviousness.

At least for this reason, Applicant respectfully submits that the Final Office Action and the Examiner's Answer have not made a *prima facie* case of obviousness of claim 4, and claim 4 is separately patentable over the references.

D. Rejection of Dependent Claim 9

According to the additional limitations of claim 9, "the retrieved data is stored in a local database which is smaller than the at least one database, thereby enabling the user to interact with the system without having to traffic data through a network and thus at a faster speed than would be possible if the user had to traffic data through the network." In the Appeal Brief we argued that Danish does not disclose or suggest storing the retrieved data in a smaller database, or storing the retrieved information in a local database, thereby enabling the user to interact with the system without having to traffic data through a network. The Examiner's Answer apparently admits (page 10) that the underlined portion was not considered, alleging that it provides no functionality. Whether or not the reduction of data traffic through a network is a separate limitation or a benefit necessarily flowing from the use of a local database, Danish's web browser does not achieve such reduction. If we accept the position that a local database necessarily reduces the network traffic, then Danish's web browser is not a "local database" because it does not achieve this result; if we do not accept this position, then the underlined verbiage is a separate limitation that has not been considered.

The Examiner's Answer further asserts (still on page 10, last 4 lines) that Danish suggests the limitation in question, citing Figure 25 and text in column 9, lines 1-3, and in column 19, lines 1-40.

The undersigned attorney has reviewed the cited Figure and text, but has not identified such suggestion. To the contrary, in column 19 Danish discloses how the data are trafficked through the network:

The client 126 initiates a request to the server 125 for the electronic catalog searching application via the Internet. The server 125 detects the request. Receipt of the request executes the requested application on the server 125 that permits a user on the client 126 to select a family 1 or subfamily 2. Example of Main Menu, Alphabetical search, Picture Search, and View Part Number screens are shown in FIGS. 31 through 35. When the family 1 or subfamily 2 is chosen, the server 125 sends a feature screen status 127 to the client 126. The feature screen status 127 comprises a feature screen code, ScreenNum 102 in a preferred embodiment, all features 5 appropriate to the feature screen 9 specified in ScreenNum 102, all available alternatives 7, all unavailable alternatives 8, and the selection criteria 14. As the selection criteria 14 is always sent, it may comprise zero selected alternatives 37. It is apparent, therefore, that the server 125 sends all of the information necessary to define the current subfamily 2 to the client 126. The information, therefore, need not be retained in memory on the server 125. This particular feature renders it particularly appropriate for an Internet environment. The client 126 receives the feature screen status 127 and displays the feature screen 9 accordingly. An example of the feature screen 9 on the Internet is shown in FIG. 26 through 29. The user on the client, makes selections from among the available alternatives 7 generating a selection criteria 14 different from that which was set to it. The client 126 initiates a search with the modified selection criteria 14. The client 126 sends to the server 125, the ScreenNum 102 value sent to it by the server, and the modified selection criteria 14. The server 125 receives the ScreenNum 102 and the selection criteria 14. The server 125 executes the search operation as disclosed hereinabove using the revised selection criteria 14 and generates the feature screen status 127. The server 125 sends the feature screen status 127 that has been updated based on the modified selection criteria 14 to the client 126. The client 126 receives the feature screen status 127 and displays the updated feature screen 9. This process may iterate similar to the local version to further narrow the subfamily as desired.

Danish, col. 19, lines 1-39 (underlining added for emphasis).

The Final Office Action and the Examiner's Answer disregarded the following limitation recited in claim 9: "thereby enabling the user to interact with the system without having to traffic

data through a network and thus at a faster speed.” But to make a *prima facie* case of obviousness, the prior art references “must teach or suggest all the claim limitations.” MPEP § 2143.

At least for these reasons, Applicant respectfully submits that the Final Office Action and the Examiner’s Answer have not made a *prima facie* case of obviousness, and claim 9 is separately patentable over the references.

E. Rejection of Dependent Claim 19

With respect to claim 19, we argued in the Appeal Brief that the references do not disclose or suggest adding matching items to an array of recommendations. According to the Examiner’s Answer (page 11), “claims 6 and 8 of the Danish reference clearly teach the user making a request to be shown an additional item” Our point, however, was and continues to be that according to claim 19 the user can specify additional matching items to be added to an array of recommendations presented to the user. In Danish, the user goes through an interactive/iterative selection and search process. The user makes selections of parametric search criteria, and obtains search results, rather than recommendations based on intelligence rules and the user’s profile. Furthermore, it appears that the user does not directly add items to such search results, but rather through changing (broadening) search criteria and obtaining new search results. *See, e.g.*, Danish, col. 22, lines 12-20 (Danish’s claim 8).

Applicant respectfully submits that at a *prima facie* case of obviousness of claim 19 has not been made, and that this claim is separately patentable over the references.

F. Rejection of Dependent Claims 20 and 21

The Final Office Action and the Examiner's Answer do not construe or otherwise address the additional limitations recited in claim 20. In particular, neither the Action nor the Answer points to any specific disclosure in the references as disclosing means to allow the user to override a predetermined intelligence rule.

With respect to claim 21, the Final Office Action acknowledged (page 9) that Danish and Weaver do not specifically teach the predetermined intelligence rules that pertain to determining whether two colors match. The Final Office Action then sought to supplement Danish, Official Notice, and Weaver with disclosure made in Hashimoto. To justify such combination, the Final Office Action asserted that it would have been obvious to combine Danish and Weaver with Hashimoto "because this would provide an additional feature that users, perhaps color blind or lacking in taste, could use to assure that the clothing being bought matches." In the Appeal Brief we argued that even if the rationale offered in the Final Office Action in support of combining the references suggested employing a color coordination rule, it does not explain why the system would allow the user to override this rule, as recited in claim 20, from which claim 21 depends. The Examiner's Answer (page 11) now asserts that Hashimoto "is suggesting a combination that would provide a certain desired result and is not static in requirement thus providing choice." The gist of this "flexibility" argument appears to be that Hashimoto does not exclude the combination, and therefore the references can be modified to create the claimed system. But "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the

prior art also suggests the desirability of the combination.” MPEP § 2143.01(III) (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)).

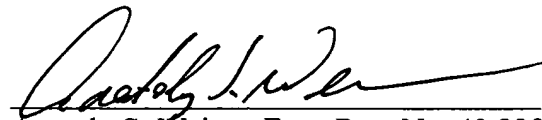
At least for this reason, Applicant respectfully submits that the Final Office Action and the Examiner’s Answer failed to make a *prima facie* case of obviousness of claims 20 and/or 21, and each of these claims is separately patentable.

IV
CONCLUSION

For the foregoing reasons, Appellant submits that all pending claims are patentable and requests reversal of the rejections.

Respectfully submitted,

Dated: December 29, 2006


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